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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,716	06/01/2001	Brian M. Siegel	SONY-95	1430

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EXAMINER

RHODE JR, ROBERT E

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,716

Applicant(s)

SIEGEL ET AL

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 recites the limitation "the database of transaction records". There is insufficient antecedent basis for this limitation in the claim. In addition, Claim 10 recites the limitation "the transaction limitation". There is insufficient antecedent basis for this limitation in the claim

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 - 7 are rejected under 35 U.S.C. 102(e) as being unpatentable over DiAngelo (US 6,101,482).

Regarding claim 1, DiAngelo teaches a method of facilitating a transaction between a merchant and a customer with a customer data storage device, the method comprising: electronically storing a customer profile on the customer data storage device (see at least Abstract and Col 5, lines 40 – 46); electronically communicating the customer profile from the customer data storage device to the merchant in conjunction with the transaction (see at least Col 5, lines 40 – 52 and Col 6, lines 45 – 49); and electronically storing a record of the transaction on the customer data storage device (see at least Col 6, lines 1 – 9).

Regarding claim 2, DiAngelo teaches a method, wherein the transaction comprises a retail purchase of a product, the method further comprising: electronically communicating data regarding the transaction to a source of the product (Col 6, lines 45 – 49).

Regarding claim 3, DiAngelo teaches a method, wherein electronically communicating data regarding the transaction to the source of the product comprises electronically communicating customer and product identification for product registration (Col 7, lines 8 – 10).

Regarding claim 4, DiAngelo teaches a method, wherein the customer data storage device comprises a card bearing a magnetic recording medium, and wherein

electronically storing to the customer data storage device comprises writing digital data to the magnetic storage medium. Please note that DiAngelo does not specifically disclose a magnetic recording medium such as a smart card. However, smart cards were old and well known at the time of the applicant's invention to one of ordinary skill. In that regard, it would have been obvious to one of ordinary skill in the art to have extended DiAngelo with a smart card in order to provide a card with access profile information, which provides the ability to shop off line without losing the control.

Regarding claim 5, PDA's were old and well known to one of ordinary skill in the art at the time of the applicant's invention. Therefore, it would have been obvious to one of ordinary skill in the art to extend the method of DiAngelo with PDA's, which will enhance mobility and not limit shopping from just a single location.

Regarding claim 6, DiAngelo teaches a method, wherein electronically storing a customer profile further comprises storing at least one of a grouping consisting of a name, a residential address, and an identification number (Col 5, lines 40 – 46).

Regarding claim 7, DiAngelo teaches a method, further comprising: reading the transaction record on the customer data storage device, and reporting the transaction record (Col 6, lines 4 – 9).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiAngelo (US 6,101,482) in view of Burge (US 6,014,638).

DiAngelo substantially discloses and teaches the applicant's invention.

While DiAngelo does disclose wherein the customer storage device includes a plurality of transaction records, DiAngelo does not specifically disclose and teach analyzing the plurality of transaction records for a pattern of customer preferences; and recommending a future transaction based on the pattern of customer preferences.

On the other hand and regarding claim 8, Burge teaches a method further comprising: analyzing the plurality of transaction records for a pattern of customer preferences; and recommending a future transaction based on the pattern of customer preferences (see at least Abstract and Col 7, lines 5 – 11).

It would have been obvious to one of ordinary skill in the art to have provided the method of DiAngelo with the method of Burge to have enabled a method for further comprising: analyzing the plurality of transaction records for a pattern of customer preferences; and recommending a future transaction based on the pattern of customer preferences – in order to have recommend potentially useful selection. DiAngelo discloses wherein the customer storage device includes a plurality of transaction records (Abstract). Burge discloses a method further comprising: analyzing the plurality

of transaction records for a pattern of customer preferences; and recommending a future transaction based on the pattern of customer preferences (Abstract and Col 7, lines 32 – 37). In that regard, one of ordinary skill in the art would have been motivated to extend the method of DiAngelo with a method further comprising: analyzing the plurality of transaction records for a pattern of customer preferences; and recommending a future transaction based on the pattern of customer preferences. Thereby, the customer is provided with useful recommendations and thereby will increase the probability that they will recommend the method for others.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiAngelo (US 6,101,482) in view of Kolls (US 6,609,103 B1).

DiAngelo discloses and teaches substantially the applicant's invention:

However, the DiAngelo does not specifically disclose the synchronizing of databases with subsequent communications.

On the other hand and regarding claim 9, Kolls does teaches a method, further comprising: remotely maintaining at least a portion of the customer profile and database of transaction records associated with the customer profile on the customer data storage device; and synchronizing the database of transaction records with the customer data storage device in response to subsequent availability of electronic

communication between the database and the storage device after an intervening transaction wherein a transaction record was stored on only one of the database and the storage device (see at least Col 3, lines 57 – 60).

It would have been obvious to one of ordinary skill in the art to have provided the method DiAngelo with the method of Kolls to have enabled a method for synchronizing of databases with subsequent communications – in order to ensure the databases have the same data. DiAngelo discloses a method wherein the customer storage device includes a plurality of transaction records (Abstract). Kolls discloses a method for the synchronizing of databases with subsequent communications (Col 3, lines 57 – 60). Thereby, one of ordinary skill in the art would have been motivated to extend the method of DiAngelo with the method for the synchronizing of databases with subsequent communications.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 – 12 and 17 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiAngelo (US 6,101,482) in view of Franklin (US 6,125,352).

Regarding claim 10, DiAngelo teaches a method of affecting purchase transactions of a subordinate person with a customer data storage device, the method comprising: storing a controlled customer profile on the customer data storage device (see at least Abstract and Col 5, lines 40 – 46); associating a financial credit identifier with the controlled customer profile (see at least Col 5, line 42).

However, DiAngelo does specifically disclose and teach a method for electronically communicating the transaction limitation from the customer data storage device to the merchant; and preventing authorization of the purchase transaction based on the transaction limitation.

On the other hand, Franklin teaches a method for electronically communicating the transaction limitation from the customer data storage device to the merchant; and preventing authorization of the purchase transaction based on the transaction limitation (see at least Abstract and Col 7, lines 59 – 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of DiAngelo with the method of Franklin to have enabled a method for electronically communicating the transaction limitation from the customer data storage device to the merchant; and preventing authorization of the purchase transaction based on the transaction limitation – in order to ensure that the transaction

does not exceed specified limitations. DiAngelo discloses a method of affecting purchase transactions of a subordinate person with a customer data storage device, the method comprising: storing a controlled customer profile on the customer data storage device; associating a financial credit identifier with the controlled customer profile (see at least Col 5, line 40 - 46). Franklin discloses a method for electronically communicating the transaction limitation from the customer data storage device to the merchant; and preventing authorization of the purchase transaction based on the transaction limitation (see at least Abstract and Col 7, lines 59 – 67). In this manner, the customer is assured that their transactions are not compromised or not appropriately in line with the established limitations.

Regarding claim 11, DiAngelo teaches a method, further comprising: storing a transaction limitation in the controlled customer profile Abstract and Col 5, lines 40 – 46).

Regarding claim 12, Franklin teaches a method, wherein electronically communicating the transaction limitation from the customer data storage device to the merchant is in response to presenting the financial credit identifier for a purchase transaction (Col 7, lines 59 – 62).

Regarding claim 17, Franklin teaches a method, further comprising: locking the controlled customer profile on the customer storage device; unlocking the controlled

customer profile in response to satisfaction of an access criterion; and modifying the transaction limitation after unlocking the customer profile (see at least Col 7, lines 59 – 67).

Regarding claim 18, Franklin teaches a method, wherein the access criterion is an encryption key and locking the controlled customer profile comprises encrypting the controlled customer profile with the encryption key. Please note that Franklin does not specifically disclose an encryption key. However, Franklin does disclose encryption. In that regard, one of ordinary skill in the art would have been motivated to extend the method of Franklin with an encryption key in order to access the customer profile.

Claims 13 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of DiAngelo and Franklin as applied to claim 10 above, and further in view of Solokl (US 6,173,269 B1).

The combination of DiAngelo and Franklin substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose and teach a method wherein storing the transaction limitation further comprises specifying an excluded merchant that is not authorized for purchase transactions; wherein storing the transaction limitation further comprises specifying an included merchant that is authorized for

purchase transactions wherein storing the transaction limitation further comprises specifying an excluded product that is not authorized for purchase transactions; wherein storing the transaction limitation further comprises specifying an included product that is authorized for purchase transactions.

On the other hand and regarding claim 13 and related claim 15, Solokl teaches a method, wherein storing the transaction limitation further comprises specifying an excluded merchant that is not authorized for purchase transactions (see at least Col 5, lines 56 – 67).

Regarding claim 14 and related claim 16, Solokl teaches a method, wherein storing the transaction limitation further comprises specifying an included merchant that is authorized for purchase transactions (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of DiAngelo and Franklin with the method of Solokl to have enabled a method wherein storing the transaction limitation further comprises specifying an excluded merchant/product that is not authorized for purchase transactions; wherein storing the transaction limitation further comprises specifying an included merchant/product that is authorized for purchase transactions – in order to control which sites are accessed. The combination of DiAngelo and Franklin disclose a method of affecting purchase transactions of a subordinate person with a customer

data storage device, the method comprising: storing a controlled customer profile on the customer data storage device; associating a financial credit identifier with the controlled customer profile; electronically communicating the transaction limitation from the customer data storage device to the merchant; and preventing authorization of the purchase transaction based on the transaction limitation. Solokl discloses a method for wherein storing the transaction limitation further comprises specifying an excluded merchant/product that is not authorized for purchase transactions; wherein storing the transaction limitation further comprises specifying an included merchant/product that is authorized for purchase transactions (Abstract and Col 5, lines 56 – 67). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of DiAngelo and Franklin with a method wherein storing the transaction limitation further comprises specifying an excluded merchant/product that is not authorized for purchase transactions; wherein storing the transaction limitation further comprises specifying an included merchant/product that is authorized for purchase transactions. In this regard, the method will ensure parents that their children cannot access sites, which were not approved. Thereby, the method will increase customer/parent satisfaction, which will increase the probability that they will purchase the method again in the future.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

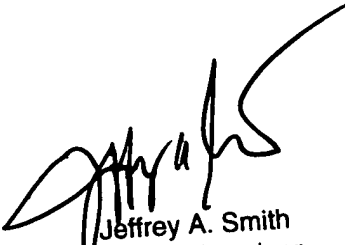
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RER



Jeffrey A. Smith
Primary Examiner